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| 08/839,161 | 04/22/1997 | WILLIAM P. NEWTON | | 9755 |

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EXAMINER

STRIMBU, GREGORY J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3634

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/839,161

Applicant(s)

NEWTON ET AL.

Examiner

Gregory J. Strimbu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2001 and 12 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 39-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 39-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

Claims 12-25 and 39-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as “predetermined profile extending evenly” on line 7 of claim 12 render the claims indefinite because it is unclear what the profile extends evenly with. Recitations such as “window jambs” on line 4 of claim 18 render the claims indefinite because it is unclear if the applicant is referring to the window jambs set forth above or is attempting to set forth window jambs in addition to the ones set forth above. Recitations such as “configures” on line 2 of claim 21 render the claims indefinite because it is unclear how the profile can “configure” a groove. It would appear that the profile has or includes the groove rather than configures the groove. Recitation such as “establishing an elevational configuration of the element” on line 4 of claim 39 render the claims indefinite because it is unclear what comprises an “elevational configuration”. Recitations such as “support regions” on line 11 of claim 53 render the claims indefinite because it is unclear what element includes the support regions the applicant is referring to. Recitations such as “a support arm secured to each sash stile” on line 8 of claim 67 render the claims indefinite because it is unclear how one support arm can be attached to both sash stiles. Recitations such as “upwardly of the shoes” on line 14 of claim 80 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Is the applicant referring to lifting the sash upwardly with respect to the shoes?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 39-41 and 44-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Osten. Osten discloses a sash support system comprising a plurality of sash support elements each formed of a metal having an evenly extending profile establishing an elevational configuration of the element, the elevational configuration of a first one of the elements integrally forming a shoe 92 having a hook shaped upper region 82 engaging a counterbalance 78 and a platform shaped lower region 102 supporting a sash 20, the elevational configuration of a second one of the elements 50 integrally forming a sash support arm pivotally connected to a stile of the sash to engage the sash supporting region of the shoe, a shoe lock 98 (claim 40), a pin 106 (claim 41), a guide 110 (claim 45), a mounting bracket 36, 38 (claim 48).

Claims 74-90 are rejected under 35 U.S.C. 102(b) as being anticipated by Trout. Trout, in figures 3 and 4, discloses a system counterbalancing a laterally removable sash 24 supported by counterbalanced sash shoes 130 respectively running vertically in opposed jambs arranged along opposite stiles of the sash, the system comprising support arms 162 extending between the sash and sash shoes 130 biased upward at lifting regions spaced from each sash stile, the support arms being arranged for

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transferring the weight of the sash to the shoes at support regions vertically below the lifting regions to minimize any moment arms tending to turn the shoes around horizontal axes, and the support arms moving to downwardly hanging positions upon movement of the sash upward and laterally from the shoes, the support arms 162 are formed of metal (claims 76 and 77).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-15, 19, 20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osten in view of Haas. Osten discloses a system counterbalancing a window sash 20 supported by a pair of counterbalanced shoes 92 so that the sash extends between a pair of jambs from which the sash is removable by maneuvering the sash upward and laterally while the shoes are locked in the jambs, the improvement comprising the shoes having a predetermined profile extending evenly for a width of the shoes and establishing an elevational configuration of the shoes, and the elevational configuration extending integrally between a hook-shaped upper region 82 formed to interconnect with a counterbalance element 78 and an lower region 102 forming a platform extending toward the sash from vertically below the upper region, sash support

arms 50 (claim 13), the shoes include locking projections 98 (claim 16), a guide 106 (claims 19, 20). Osten is silent concerning an L-shape.

However, Haas discloses shoes 65 having an L-shaped configuration.

It would have been obvious to one of ordinary skill in the art to provide Osten with an L-shaped configuration, as taught by Haas, to increase the locking force of the shoes.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osten in view of Haas as applied to claims 12-15, 19, 20 and 22-24 above, and further in view of Johnson. Johnson discloses jamb projections.

It would have been obvious to one of ordinary skill in the art to provide Osten, with jamb projections, as taught by Johnson, to more securely hold the shoes in a locked position.

Claims 61, 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osten in view of Johnson. Osten discloses a system locking counterbalance shoes 92 to window jambs while a sash 20 supported on the shoes is removed from between the window jambs, the system comprising the shoes having hooks 98 that are pivotally mounted on lower regions of the shoes to move between latched and unlatched positions. Osten is silent concerning hooks hanging dependently downward from the shoes.

However, Johnson discloses a system comprising shoes 13 having hooks 17 that are pivotally mounted on lower regions of the shoes to move between latched and unlatched positions, the hooks in unlatched positions hanging dependently downward from the shoes to engage the jambs and hook under lances 21 formed in the jambs as the shoes rise, and the hooks in latched positions being retained out of engagement with the jambs and clear of the lances.

It would have been obvious to one of ordinary skill in the art to provide Osten with hooks, as taught by Johnson, to increase the locking forces of the shoes when not in engagement with the sash.

Allowable Subject Matter

Claims 1-11 are allowed.

Claims 18, 21, 42, 43, 53-60, 62, 63, 66-73 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach the combination of a sash, opposed window jambs, and a pair of sash support arms mounting to hang freely downward on respective opposite sides of the sash. See claim 1, lines 4.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach the combination of a window sash, a pair of counterbalanced shoes wherein the locking elements formed as hooks that catch on the jamb projections and the shoes have latches that latch the locking elements in undeployed positions out of engagement with the window jambs. See claim 18, lines 1-4.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach the combination of a window sash, a pair of counterbalanced shoes wherein the profile having a latch retaining groove and a pin groove for receiving a pivot pin of the shoe hook. See lines 1-3 of claim 21

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach a resilient latch mounted on the shoe for retaining the shoe in the undeployed position. See lines 1-2 of claim 42.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach sash support arms movably mounted respectively on each

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stile of a sash so that the support arms hang downward in dependent positions when not supporting the sash and move outward to braced positions in response to engagement of the support arms with locked sash shoes as the sash is lowered between the shoes so that the weight of the lowered sash urges the sash support arms outward on the shoes to the braced positions. See lines 2-9 of claim 53.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach resilient latches carried on the shoes for holding the hooks in the latched positions. See lines 1-2 of claim 62 and lines 1-3 of claim 66.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach the sash having a support arm secured to each sash stile so that the sash support arms hang downward in positions in which lower ends of the support arm engages sash end regions of the shoe platforms when the sash and the support arms are moved downward from above the shoe platforms, the sash support arms being mounted on the sash to pivot between the downwardly hanging position and outwardly extending positions as weight of the downwardly moved sash transfers to the shoes via the support arms. See lines 8-19 of claim 67.

Response to Arguments

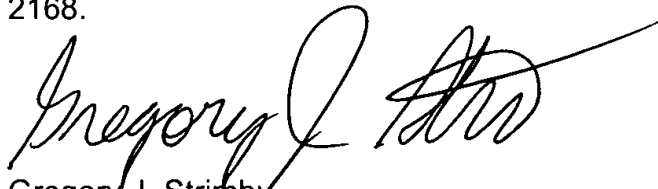
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Applicant's arguments, filed August 6, 2001, have been fully considered but they are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a long horizontal flourish extending to the right.

Gregory J. Strimbu
Primary Examiner
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October 20, 2003